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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,764	08/10/2000	Dah-Ben Liang	36912/CM/S61	7809

7590 04/17/2002

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EXAMINER

SCHOEPPPEL, ROGER J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637764

Applicant(s)

LIANG ET AL

Examiner

SCHOEPPPEL

Group Art Unit

3672

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE TWO MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on February 6, 2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4 & 7-37 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-3, 7-27, 36 & 37 is/are allowed.
- ☒ Claim(s) 4 & 28-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3672

DETAILED ACTION

1. The Consent of Assignee to reissue signed by the Chief Patent Counsel on 8/7/00 is unacceptable. The Consent must clearly be signed by an officer of the company or state that the individual named is empowered to sign on behalf of the Assignee. The Consent previously submitted is missing this acknowledgment.
2. The four Declarations for Reissue previously submitted lack a post office address for each of the coinventors. New Declarations for Reissue are required providing this information. If their resident address is the same as their post office address, the Declaration for each coinventor should so state this fact.

Further, the set of Declarations originally submitted only specified that the particular error cited arose without deceptive intent. The submission of new Declarations in response to this office action which include the additional address information, because of reference to 16 mesh particles, inter alia, also needs to be updated to say that "All errors not covered by the earlier submitted Declarations arose without deceptive intent."

3. According to 37 CFR 1.173 (d), changes in the claimed matter to be omitted by reissue must be enclosed in brackets and matter to be added by reissue must be underlined. Accordingly, the Amendment filed February 6, 2002, and entered as Paper No. 6, is improper as it does not meet the requirements of 37 CFR 1.173. It is suggested applicants refile this amendment including the arguments presented therein only incorporating the amended claims (as shown on the attachment entitled "VERSION WITH MARKING TO SHOW CHANGES MADE") in the text of the amendment and deleting (unentering) the clean copy of all of the claims previously included in the text of the amendment all so as to meet the requirements of 37 CFR 1.173(d).
4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as their invention.

In claim 4, the "100 percent" is limited to --99 percent-- by the terms of the independent claim.

Art Unit: 3672

5. Claims 28-35 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The independent claims 28 and 32 call for a particle size that is "less than 40 mesh" and "greater than 80 mesh", respectively. These features make claims 28-35 indefinite as these limits may encompass values beyond those disclosed and therefor constitute new matter.


6. Claims 28-35 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Roger Schoepfel whose telephone number is (703) 308-2147. The examiner can normally be reached on Monday through Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for this Art Unit is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

R. Schoepfel/rjs
April 16, 2002


ROGER SCHOEPPÉL
PRIMARY EXAMINER
ART UNIT 3672